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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,498	12/14/2001	William E. Pence	3652/0K015	5619

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/017,498

Applicant(s)

PENCE ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1-21 have been examined.

Response to Arguments/Amendments

2. The Applicant is of the opinion that the prior art does not teach transparently transmitting a license file to a user (paper no. 6, page 11, lines 20-22). To support the Applicant's position, Applicant equates the word "transparency" with "without notifying a user". However this clearly contradicts the accepted meaning of the term, as "transparent", according to Webster's Ninth Collegiate Dictionary, is defined as "free from pretense or deceit", "obvious", "clear" and "easily detected". Hence, to one of ordinary skill, Hortsman teaches transmitting a license file to a user transparently- i.e. in the clear (figures 1 and 2). The Applicant has made other remarks concerning the appliance of the prior art, however, they are general and do not specifically point out differences between the **claims** and the prior art. Therefore, the Examiner maintains the rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 in view of Hortsman, U.S. Patent No. 6,009,401.

As per claims 1-7 and 10-21, Rivera et al. licensing system comprising:

- A processor and memory storing instructions for controlling the processor (figures 1; column/line 4/54-6/2)
- creating a license file having one or more parameters (column 8, lines 32-34)
- transmitting content from a provider system to a user (column/line 5/52-6/2)
- comparing license parameters to determine whether or not a user is allowed to access content and renewing parameters in the license file to allow continued access to the content by the user in accordance with license parameters (column/line 8/35-9/14)
- storing license file parameters using a subscription system (figure 3)

- storing downloaded content on a user database (figure 3; column/line 5/52-6/2)
- a subscription management service operable to monitor and store one or more license file parameters (figure 3)

Rivera et al. also teach client application for receiving user input and providing user input to communication application, license storage and content storage, as it would have been obvious to combine the server that stores the monitoring routine with the server that disseminates the software (figures 3-5B; column/line 5/52-6/57). However, Rivera et al. do not explicitly recite transmitting a license file to a user. Hortsmann teaches a transmitting, from a provider system, a license file, that contains user technical information and type of content, for storage on a user system (figures 1 and 2; column/line 3/43-4/11). Hortsmann also teaches a license file stored on a license server and client system (figures 1 and 2), a license server generating the license file for a user (column/line 3/65-4/11), storing license file parameters in a registry (column/line 3/43-4/11).

Therefore, it is at least obvious that the file was created and transferred via the license server. Rivera et al. do not explicitly recite disseminating content with license. On the other hand, Rivera et al. teach disseminating content using a server (column/line 5/52-6/2), while Hortsmann teaches delivering content with license offline (figure 3) hence it would have been obvious to one of ordinary skill

to distribute the content with the license electronically. Therefore it would have been obvious to one of ordinary skill to combine the teachings of Rivera et al. and Hortsman in order to include license terms such as the number of computers allowed to access software (i.e. number of licenses), access license data stored on a user system ('401, column 3, lines 44-51), determine whether a customer is in compliance with the license terms, offer the customer the opportunity to come under license compliance without interrupting the customer's business and update the license file accordingly (e.g. purchase extra licenses) ('786, figures 5A-B; column 8, lines 35-47; '401, column 3, lines 44-51).

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 and Hortsman, U.S. Patent No. 6,009,401 as applied to claim 1 in further view of Johnson et al., U.S. Patent No., 5,023,907.

As per claims 8 and 9, Rivera et al. teach a license compliance monitoring system (figure 3) while, Hortsman teaches transmitting a license file to a user (figures 1 and 2; column/line 3/43-4/11). However, neither reference explicitly recites creating individual license files for individual content items and one license file for a plurality of items. Johnson et al. teach a licensing system that creates individual license files for individual content items and one license file for

a plurality of items (figure 2). Therefore, it would have been obvious to combine the systems of Rivera et al., Hortsman and Johnson et al. in order to permit an end-user to more accurately account for licensed products ('907, figure 2).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

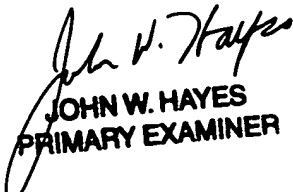
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

July 1, 2003


JOHN W. HAYES
PRIMARY EXAMINER